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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,506	03/29/2000	Judith Continelli	10655.9400	6236

7590

03/28/2003

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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

81

Office Action Summary	Applicati n N .	Applicant(s)	
	09/537,506	CONTINELLI ET AL.	
	Examin r	Art Unit	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --
Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2003 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25th, 2003 has been entered.

Response to Arguments

1. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The inventive concept such as "*pre-existing ... having pre-defined content*" described in claims 1, 7, 15, 23 and 33 are not disclosed in the specification.

Art Unit: 3621

Although applicant disclosed forms stored and retrieved from a server, it appears that the concept of pre-existing form is an integral inventive concept in this application. Moreover, Applicant arguments are centered around this particular inventive concept.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noblett Jr. et al. (U.S. Patent No 5,432,326 (*applicant IDS*) in view of Collins et al (2002/0007362 A1).

6. As per claim 1, Noblett Jr. et al teach a system for facilitating the handling of a transactional dispute (*dispute regarding transaction*) comprising: at least one access terminal (*back office computer, 57*) having a display and an input means (*see fig 2*); a central server (*host computer, 40*) having an Internet web site stored thereon, the display capable of displaying a plurality of dispute handling forms retrieved from the server and the web site (*see fig 2*) a communication channel (*LAN, 58a, 58b*) linking the terminal to the web site and the server to the web site; (*see fig 10, and fig 15, also, column 4 lines 24-55*)). Noblett Jr. et al fail to teach an inventive concept for facilitating the handling of a post-transactional dispute. However, Collins et al teach an inventive concept for facilitating the handling of a post-transactional dispute (*see page 3, paragraph no. 041*). Therefore, it would have been obvious to one of ordinary skill in the

Art Unit: 3621

art at the time the invention was made to modify Noblett et al's inventive concept to include Collins et al's inventive concept for facilitating the handling of a post-transactional dispute because this would have provided a system wherein the statistical data pertaining to previous resolutions to a similar situation may be particularly useful in aiding in the resolution of the present and future situation.

7. As per claims 2, 4, Noblett Jr. et al teach a system comprising a first access terminal for a dispute initiator/issuer and a second access terminal for a dispute responder/acquirer ((*see fig 1, 2*).

8. As per claims 3, 5, Noblett Jr. et al teach a system comprising a form selection for a dispute initiator and a form selection for a dispute responder wherein the form selection for the initiator comprises a Retrieval Request , a First Chargeback and a Final Chargeback; and the form selection for the responder comprises a Fulfillment and a Second Presentment (*see fig 10, and fig 15, also, column 4 lines 24-55*).

9. As per claim 6, Noblett Jr. et al teach a system comprising a third access terminal for administration and a fourth access terminal for finance (*see fig 1, 2*).

10. As per claim 7, Noblett Jr. et al teach a method for handling a dispute between an Issuer (*card issuing, 18a*) and an Acquirer (*merchant, 16*) via an Internet connection (*network, fig 12*) to which are coupled at least one access terminal (*host computer 40, back office computer 57, card issuer computer 19a*) (*see fig1 1, 2*), the method comprising accessing an Internet web site

Art Unit: 3621

from the terminal, the web site linked to a server comprising a plurality of dispute handling forms stored thereon choosing one of the dispute handling forms, responding to the requested field information on the form, sending the form over the Internet connection to be routed by the server to a disputed party; and repeating steps (a)-(d) for both the Issuer and the Acquirer (*see fig 10, and fig 15, also, column 4 lines 24-55*). Noblett Jr. et al fail to teach an inventive concept for facilitating the handling of a post-transactional dispute. However, Collins et al teach an inventive concept for facilitating the handling of a post-transactional dispute (*see page 3, paragraph no. 041*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Noblett et al's inventive concept to include Collins et al's inventive concept for facilitating the handling of a post-transactional dispute because this would have provided a system wherein the statistical data pertaining to previous resolutions to a similar situation may be particularly useful in aiding in the resolution of the present and future situation

11. As per claim 8, Noblett Jr. et al teach a method further comprising at least one document scanning device and scanning at the document scanning device at least one supporting document; and sending the supporting document along with the form over the Internet connection to be routed by the server to a disputed party (*see fig 1, 2*).

12. As per claim 9, Noblett Jr. et al teach a method wherein the scanning comprises one to five supporting documents (*see fig 1, 2*).

13. As per claim 10, Noblett Jr. et al teach a method further comprising reviewing a report comprising the form by financial operations; and transferring liability in response to the report to

Art Unit: 3621

at least one of the Issuer from Acquirer and the Acquirer from the Issuer (*see fig 10, and fig 15, also, column 4 lines 24-55*).

14. As per claim 11, Noblett Jr. et al teach a method of requesting a User ID from administrative operations; and receiving the User ID and a password (*see fig 10, and fig 15, also, column 4 lines 24-55*).

15. As per claim 12, Noblett Jr. et al teach a method wherein the choosing one of the dispute handling forms comprises choosing from a form selection for the Issuer and a form selection for the Acquirer (*see fig 10, and fig 15, also, column 4 lines 24-55*).

16. As per claim 13, Noblett Jr. et al teach a method wherein the form selection for the issuer comprises a Retrieval Request, a First Chargeback and a Final Chargeback; and the form selection for the Acquirer comprises a Fulfillment and a Second Presentment (*see fig 10, and fig 15, also, column 4 lines 24-55*).

17. As per claim 14, Noblett Jr. et al teach a method wherein the sending step comprises one of viewing and downloading by the disputed party (*see fig 10, and fig 15, also, column 4 lines 24-55*).

18. As per claim 15, Noblett Jr. et al teach a method executed in a network computer system for facilitating handling of transactional disputes, the network computer system having a server and at least one access terminal ((*see fig 1, 2*), comprising accepting at the server a User ID and

Art Unit: 3621

password from a first user at a first access terminal (*see column 14 lines 42-54*), retrieving from the server a set of dispute handling forms which coincide with the User ID (*see column 14 lines 42-54*), displaying the set of first user forms at the first access terminal (*see fig 1, 2*), receiving input entered on one of the first user forms at the first access terminal (*see fig 10, and fig 15, also, column 4 lines 24-55*)), transmitting within the network the one of the first user forms to a second user in dispute with the first user (*fig 26, column 54 line 50- 55 line 44*), notifying the second user at a second access terminal of the one of the first user forms (*see fig 10, and fig 15, also, column 4 lines 24-55*), accepting at the server a User ID and password from the second user at the second access terminal (*see column 14 lines 42-54*), retrieving from the server a set of dispute handling forms which coincide with the second user User ID (*see fig 1, 2*), displaying the set of second user forms at the second access terminal (*see column 14 lines 42-54*) receiving input entered on one of the second user forms at the second access terminal; transmitting within the network the one of the second user forms to the first user (*fig 26, column 54 line 50- 55 line 44*), notifying the first user at the first access terminal of the one of the second user forms; and repeating steps (a)-(I) until all needed dispute handling forms have been transmitted (*fig 26, column 54 line 50- 55 line 44*). Noblett Jr. et al fail to teach an inventive concept for facilitating the handling of a post-transactional dispute. However, Collins et al teach an inventive concept for facilitating the handling of a post-transactional dispute (*see page 3, paragraph no. 041*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Noblett et al's inventive concept to include Collins et al's inventive concept for facilitating the handling of a post-transactional dispute because this would have provided a system wherein the statistical data pertaining to previous resolutions to a similar situation may be particularly useful in aiding in the resolution of the present and future situation

Art Unit: 3621

19. As per claims 16-39, they contain inventive concepts that are identical to claims 1-15.

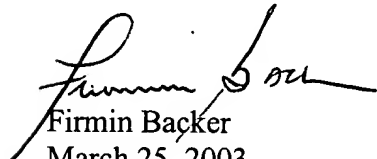
Therefore, they are rejected by the same rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Firmin Backer
March 25, 2003